

Remarks:

Claims 1–20 are pending with claims 1, 13, and 20 being independent. In the Office Action (“OA”) dated June 6, 2005, claim 12 was objected to as being unclear and including a term that lacked an antecedent basis. Claims 1–10, 13–14, and 16–20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemp, U.S. Patent No. 6,570,506, in view of Hollander, U.S. Patent No. 6,095,682. Furthermore, claims 11, 12, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemp in view of Hollander and Hersch, U.S. Patent Application Publication No. 2002/0106617. Claim 12 is presently amended.

In objecting to claim 12, the Examiner asserted that “[i]t is unclear how a remote control can facilitate picking the selected language when the memory device is removed to change the language. Also, the limitation ‘the user’ lacks antecedent basis.” Applicant initially notes that claim 12 has been amended to remove the language “the user.”

Furthermore, Applicant respectfully asserts that claim 12 is clear as written. Claim 12 depends from claim 11, and therefore currently includes the limitations “a memory device storing a database operable to contain information relating to the plurality of celestial bodies . . . wherein the memory device is removable, and the language is selected by choosing a memory device with a text file corresponding to the desired language” and “a remote control operable to facilitate picking the selected language.”

The specification explains how the remote control may facilitate picking the selected language. The specification explains, for example, that “the database [stored in the memory device] . . . may be operable to use *more than one* of the languages” and that “the user may pick the selected language from a language list in order to configure the processor.” (Emphasis added). Note that claim 12 does not limit the information stored on the removable memory device to a single language. Thus, the removable memory may include more than one language, such as English and Spanish. A user wishing to use either English or Spanish would install in the telescope the memory with English and Spanish information, and then select the desired language from a language list using the

remote control. This is but one example of an embodiment of the invention recited in claim 12.

Turning now to the rejection of claim 1 based on 35 U.S.C. § 103(a), the Office Action fails to establish a *prima facie* case of obviousness. The Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01. Finally, "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

The examiner has failed to cite references that teach or suggest all the limitations of claim 1

The references cited in the Office Action fail to teach or suggest at least a telescope with "a processor operable to convert a text file to an audio signal representative of audible speech in a selected one of a plurality of languages" as recited in claim 1. In the Office Action, it is asserted that the processor of Lemp is "operable to convert a text file (in

database 62) to an audio signal,” and column 12, lines 10–30 of Lemp are cited for support of this assertion. (OA, pages 2–3). Applicant respectfully disagrees. Column 12, lines 10–30 of Lemp disclose “*playback* of [preexisting] audio *data*,” which is entirely different than converting a text file to an audio signal, much less converting a text file to an audio signal representative of audible speech in a selected one of a plurality of languages. Applicant notes that Lemp makes *no reference whatsoever* to converting a text file to an audio signal. In fact, Lemp makes no reference to a text file or use of a text file.

Furthermore, it would not have been obvious to modify Lemp to include “a processor operable to convert a text file to an audio signal representative of audible speech in a selected one of a plurality of languages.” First, there is no suggestion or motivation, either in Lemp or in the knowledge generally available to one of ordinary skill in the art, to modify Lemp in this manner. Lemp, for example, does not disclose selecting a language at all, as conceded by the Examiner. (OA, page 3).

Second, such a modification would not be a trivial matter nor an arbitrary design choice. It will be appreciated that the processor and the memory device of the invention recited in claim 1 are both contained within a telescope enclosure, and thus form part of a stand-alone telescope that does not rely on a connection to an external device or computer network. Modifying Lemp to include a processor for converting a text file to an audio signal representative of audible speech in a selected one of a plurality of languages would at least entail reprogramming the device to perform the conversion and redesigning the system to include a memory device *within* the handheld housing (16) sufficiently large to contain all of the text files corresponding to the plurality of languages.

Therefore, Lemp fails to teach or suggest at least the limitation of “a processor operable to convert a text file to an audio signal representative of audible speech in a selected one of a plurality of languages” as recited in claim 1.

The examiner has failed to cite analogous art

Neither Hersch nor Hollander are analogous art. First, Hollander is not in the

field of applicant's endeavor. Applicant's endeavor is in the field of telescopes, and more particularly telescopes operable to audibly communicate information to a user. Hollander, in contrast, is entirely unrelated to telescopes. Hollander discloses a combined multimeter and pyrometer. (Hollander, abstract). A multimeter is an instrument for taking various types of electrical measurements (*Id.*, col. 5, lines 27–31), and a pyrometer is an instrument for measuring temperatures beyond the range of standard thermometers (*Id.*, col. 3, lines 8–14; WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1854 (1993)). Therefore, the application invention and Hollander clearly pertain to entirely different fields of endeavor.

Second, Hollander is not reasonably pertinent to the particular problem with which Applicant's invention is concerned. A person of ordinary skill in the art, seeking to improve communication of information from a telescope to a user, would not be reasonably expected or motivated to look to the pyrometer/multimeter disclosed in Hollander. (See *In re Oetiker, supra*). Furthermore, Hollander is not in an area where one of ordinary skill in the art would be aware similar problems exist. (See *Stevenson v. International Trade Comm.*, 612 F.2d 546, 550 (CCPA 1979)).

Regarding the patent to Hersch, Hersch is not in the field of applicant's endeavor. Applicant's endeavor is in the field of telescopes, and more particularly telescopes operable to audibly communicate information to a user. Hersch, in contrast, relates to a computer-administered vocational personnel assistant for assessing an individual for suitability for particular jobs (Hersch, title, abstract), and is therefore in an entirely different field of endeavor than the application invention.

Furthermore, Hersch is not reasonably pertinent to the particular problem with which Applicant's invention is concerned. A person of ordinary skill in the art, seeking to improve communication of information from a telescope to a user, would not be reasonably expected or motivated to look to the vocational personnel assistant of Hersch for guidance. Furthermore, Hersch is not in an area where one of ordinary skill in the art would be aware similar problems exist.

Therefore, both Hollander and Hersch are not analogous art, and Applicant

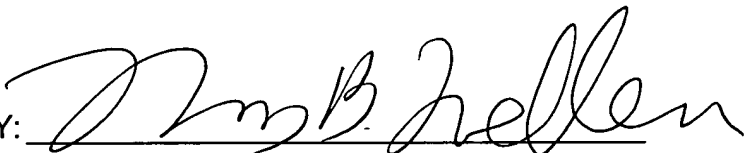
respectfully requests that the rejections based on those references be withdrawn.

Conclusion

Independent claims 13 and 20 each recite limitations similar to those of claim 1, therefore the arguments set forth above in support of claim 1 also apply to claims 13 and 20. The remaining claims depend, either directly or indirectly, from claims 1 and 13.

For at least the reasons set forth above, applicant respectfully submits that claims 1–20 are in allowable condition and requests a Notice of Allowance. In the event of further questions, the Examiner is urged to call the undersigned. Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,
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